

Image



PATENT

Customer Number: 22,852
Attorney Docket No. 04853.0079-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Kazunari TAIRA et al.) Group Art Unit: 1652
Application No.: 09/974,974) Examiner: Charles L. Patterson, Jr.
Filed: October 12, 2001)
For: NUCLEIC ACID ENZYMES)
ACQUIRING AN ACTIVITY)
FOR CLEAVING A TARGET)
RNA BY RECOGNIZING)
ANOTHER MOLECULE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants bring to the attention of the Examiner the documents listed on the attached Form PTO 1449. This Information Disclosure Statement is being filed, to the undersigned's knowledge, before the mailing date of a first Office Action on the merits for the above-referenced application.

The documents listed in this Information Disclosure Statement were first cited in a communication from the European Patent Office in a counterpart foreign application, and this Information Disclosure Statement is being filed within three months of the mailing date of that communication. A copy of the communication from the European Patent Office dated January 14, 2004, is enclosed.

The EPO communication lists eight documents, which are attached. One of the listed documents, WO 99/46388, is not in English. "Where the information is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance [under 37 C.F.R. § 1.98(a)(3)] can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office." (See MPEP §609 A(3), second paragraph.) Applicants enclose a copy of such a Search Report from a counterpart European application. The Applicants have also indicated to the undersigned that EP 1 063 296 A1, which is also cited in the Search Report and attached, is an English-language equivalent of WO 99/46388.

Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the listed documents are material or constitute "prior art." If the Examiner applies the documents as prior art against any claims in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the Office the relevant facts and law regarding the appropriate status of the documents.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should the documents be applied against the claims of the present application.

If there is any additional fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2004

By: Danielle Pasqualone
Danielle M. Pasqualone
Reg. No. 43,847

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	04853.0079-00000	Appln. No.	09/974,974
Applicant	Kazunari TAIRA et al.		
Filing Date	October 12, 2001	Group:	1652

U.S. PATENT DOCUMENTS

Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
O P E						
MAR 25 2004						
PATENTS & TRADEMARK OFFICE						

FOREIGN PATENT DOCUMENTS

	Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No
	EP 1 063 296 A1	12/27/2000	EPO			
	WO 99/46388	09/16/1999	PCT			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

	Araki et al., "Allosteric regulation of a ribozyme activity through-ligand-induced conformational change," <i>Nucleic Acids Res.</i> , 26(14):3379-3384 (1998).
	Koseki et al., "Factors governing the activity in vivo of ribozymes transcribed by RNA polymerase III," <i>Journal of Virology</i> , 73(3):1868-1877 (1999).
	Kuwabara et al., "A novel allosterically <i>trans</i> -activated ribozyme, the maxizyme, with exceptional specificity in vitro and in vivo," <i>Molecular Cell</i> , 2:617-627 (1998).
	Kuwabara et al., "Allosterically controllable maxizymes cleave mRNA with high efficiency and specificity," <i>Tibtech</i> , 18:462-468 (2000).
	Kuwabara et al., "Comparison of the specificities and catalytic activities of hammerhead ribozymes and DNA enzymes with respect to the cleavage of BCR-ABL chimeric L6 (b2a2) mRNA," <i>Nucleic Acids Research</i> , 25(15):3074-3081 (1997).
	Tanabe et al., "Maxizymes, novel allosterically controllable ribozymes, can be designed to cleave various substrates," <i>Biomacromolecules</i> , 1:108-117 (2000).
	Tanabe et al., "Oncogene inactivation in a mouse model: tissue invasion by leukaemic cells is stalled by loading them with a designer ribozyme," <i>Nature</i> , 406:473-474 (2000).

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	04853.0079-00000	Appln. No.	09/974,974
Applicant	Kazunari TAIRA et al.		
Filing Date	October 12, 2001	Group:	1652

<i>RECEIVED U.S. PATENT & TRADEMARK OFFICE MAR 25 2004</i>	OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)
	European Search Report for Application No. EP 01 30 8694, mailed January 14, 2004.

Examiner	Date Considered
<p>*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce